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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,501	12/19/2001	Joseph S. Wycech	M 6385A	9344

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EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 01/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,501

Applicant(s)

WYCECH, JOSEPH S.

Examiner

Hai Vo

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
2. Claims 1-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,372,334. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons. The combination of claims 1 and 13 of U.S. Patent No. 6,372,334 encompasses the claimed subject matter with an additional limitation of the edge feature. The combination of claims 19, 22 and 23 of U.S. Patent No. 6,372,334 reads on the claimed subject matter with an additional limitation of the presence of a means within the foam layer for adsorbing shrinkage strains due to heat cure of the foam layer and cooling of the heat substrate.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 19, 22-24, and 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Wycech (US 5,575,526). Wycech discloses a laminate support beam comprising an outer shell and an inner shell separated by a layer of structural foam (abstract and figure 10). Figures 10, 11 and 14 show the laminate support beam has a pair of longitudinal side edges interconnected by a pair of transverse end edges, at least one of the pair of side edges and end edges being non-straight and a plurality of holes 50 creating open passageways completely through the laminate. Figure 2 shows the laminate comprising a plurality of holes arranged in a random pattern. It is the examiner's position that Wycech anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 20, 21, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wycech (US 5,575,526). *In re Dailey*, 149 USPQ 47 (CCPA 1976), there is no evidence in the record to show that the particular shape of the edge of the laminate or the orientation of the holes is significant or is anything more than one of numerous

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shapes a person of ordinary skill in the art would find obvious for the purpose of providing the shape of the edge of the laminate, therefore, the wavy pattern or the sawtooth shape of the laminate edge in itself would not render the claims patentable over Wycech. See ***Graham v. John Deere Co.***,

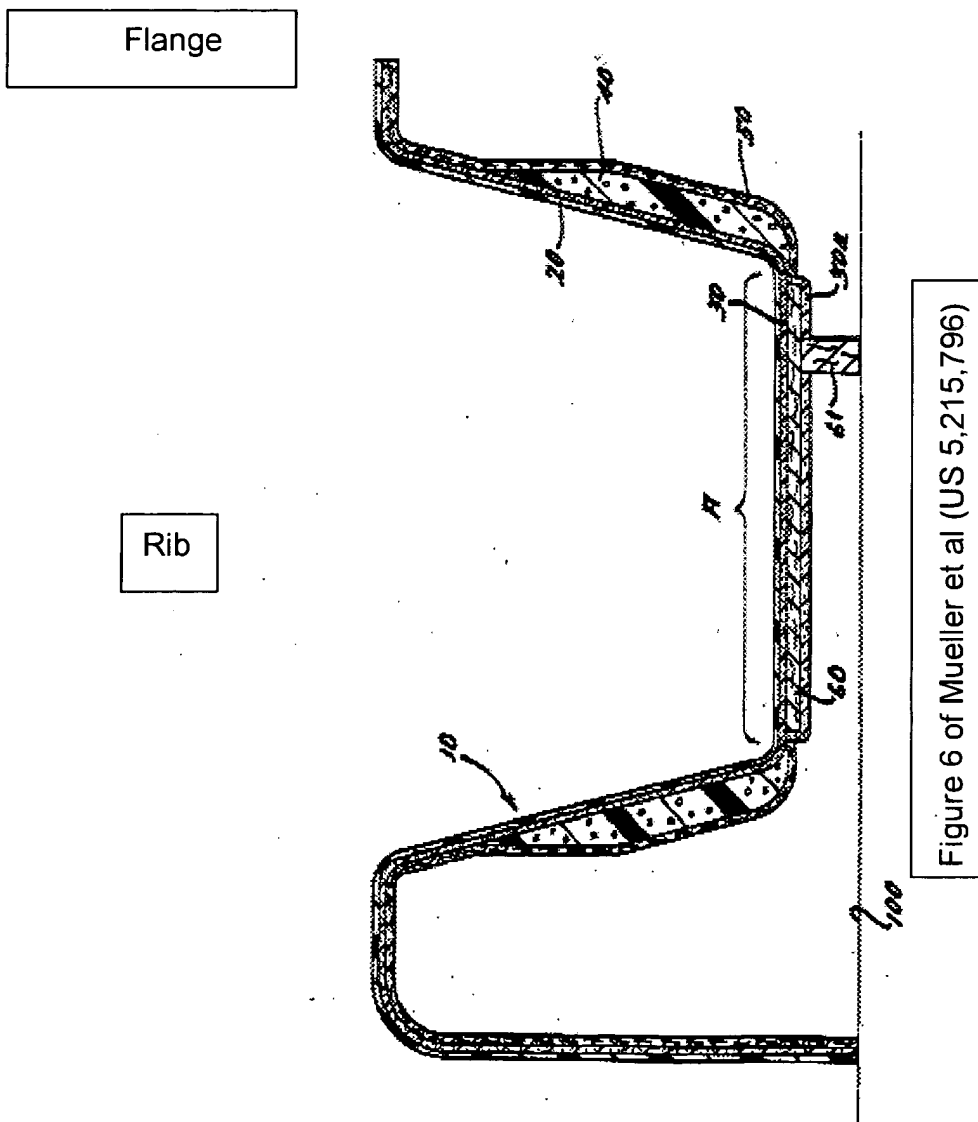
7. Claims 1, 3-6, 8-14, and 16-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al (US 5,215,796) in view of Childress (US 6,027,798). Mueller et al. teach a shaped laminate comprising a top layer of thermoset polyester resin 20, a supporting layer comprised of high density polyurethane foam 30 underneath the top layer, and a bottom layer comprised of polyurethane foam 40 beneath and in surface -to- surface contact with supporting layer. Mueller et al. teach all various resinous layers have been applied and cured on the mold (column 2, lines 50-68, column 3, lines 1-9). Mueller et al does not specifically disclose the laminate having holes completely through laminate. Childress teaches in analogous art that a laminate comprising face sheets, a foam core between the first and second face sheets, and a plurality of holes through the combination of face sheets and foam core. See abstract. Figure 5 of Childress has provided the pins comprising a plurality of uniformly and equally spaced aligned rows and columns of pins (figures 1 and 2). Childress also discloses the orientation of the pins will vary according to the needs of the particular application (column 4, lines 48-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included the laminate of Mueller a plurality of pins positioned through

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the laminate, motivated by the desire to obtain the laminate that would resist distortion and separation between layers, and maintains high structural integrity.

With regard to claims 4-6, figure 6 of Mueller is provided with support structure members 60 and 61 on the bottom wall. In addition, figure 6 of Mueller shows the laminate wherein a rib of the substrate in line with a rib of foam layers and top layer. Figure 6 of Mueller further illustrates the foam layers and top layer having end flanges.

With regard to claims 9, 10, 20 and 21, *In re Dailey*, 149 USPQ 47 (CCPA 1976), there is no evidence in the record to show that the particular shape of the edge of



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the laminate is significant or is anything more than one of numerous shapes a person of ordinary skill in the art would find obvious for the purpose of providing the shape of the edge of the laminate, therefore, the wavy pattern or the sawtooth shape of the laminate edge in itself would not render the claims patentable over

Mueller/Childress. See ***Graham v. John Deere Co.***,

With regard to claims 11-13, and 22-24, Figure 6 of Mueller also teaches claim limitations.

8. Claims 7, 15, and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al (US 5,215,796) in view of Childress (US 6,027,798) as applied to claim 1 above, further in view of LaMarca, II et al (US 5,456,976). The combination of Mueller and Childress does not specifically disclose the laminate wherein the substrate is an automobile door. LaMarca, II et al. teach in analogous art that a laminate formed from a facing layer of polymer, intermediate layer, and a backing layer. This laminate is used for mounting on the inside surface of the door panels (figure 1 and column 1, line 17). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have attached the laminate of Mueller as modified by Childress on the inside surface of an automobile door, motivated by the desire to obtain an automotive trim panel for noise abatement and safety concerns.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 4,901,500 discloses a lightweight, composite beam for reinforcing a vehicle door.

US 5,888,600 discloses a structural member having a channed-shaped laminate structure of a metal stamping metal, a channel-shaped foil and an intervening layer of structural foam.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426.

The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
January 21, 2003



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700